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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,887	09/05/2003	Valerie De La Poterie	05725.1237-00	6631
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
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08/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/654,887

Applicant(s)

DE LA POTERIE ET AL.

Examiner

JYOTHSNA A. VENKAT

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 73-100 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 73-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 06/10/2008;11/03/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of IDS and remarks filed on 6/10/08 ; terminal disclaimer and remarks filed on 9/29/08 and IDS filed on 11/3/08.

Status of claims

Claims 32-72 and 101-105 are withdrawn from consideration as being drawn to non-elected invention (election with traverse filed on 1/11/07). Claims 1-31 and 73-100 are examined in the application.

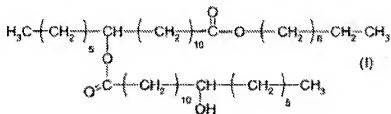
In view of terminal disclaimer , the obviousness-type double patenting of instant claims over claims 32-38 and 45-58 of co-pending application 10/654,907 is hereby withdrawn.

Claim Rejections - 35 USC § 112

Claims 1-20, 22-31 and 79-100 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

The specification discloses a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa drawn to formula (I) such as Kester Wax K 82 P (Examples), and Kester Wax 80 P in the instant application. See below for formula I.

[034] Tacky waxes that may be used include the C₂₀-C₄₀ alkyl (hydroxystearoyloxy)stearate (the alkyl group containing from 20 to 40 carbon atoms), alone or as a mixture, such as a C₂₀-C₄₀ alkyl 12-(12'-hydroxystearoyloxy)stearate, chosen from compounds of formula (I):



or a mixture of compounds of formula (I), wherein n is an integer ranging from 18 to 38.

[035] Thus, another aspect disclosed herein is a composition for coating keratin fibres, for instance a mascara, comprising, in a cosmetically acceptable medium, a C₂₀-C₄₀ alkyl (hydroxystearoyloxy)stearate (mention may be made of C₂₀-C₄₀ alkyl 12-(12'-hydroxystearoyloxy)stearate), such as those described in formula (I).

[036] Mention may be made of tacky wax that is sold under the names "Kester Wax K 82 P" and "Kester Wax K 80 P" by the company Koster Keunen.

Specification at paragraph [0161] tests different waxes. These include bees wax, hydrogenated Jojoba oil, hydrogenated castor oil, orange oil, oxypropylenated (SPO) lanolin wax. These 5 waxes tested do not meet a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa claimed in claim 1.

However tacky wax also includes the following waxes, which are not tested. These are:

1. Bayberry wax
2. Hydrogenated jojoba wax
3. Candelillia wax

4. Carnauba wax
5. Hydrogenated rice bran wax
6. Japan wax
7. Jojoba butter
8. Jojoba oil
9. Lanolin wax
10. Microcrystalline wax
11. Mink wax
12. Montan acid wax
13. Montan wax
14. Ouricurry wax
15. Ozokerite wax
16. Rice bran wax
17. Shellac wax
18. Synthetic wax an
19. Synthetic Beeswax (no formula)

The specification provides insufficient written description to support the genus encompassed by the claim having a tacky wax of tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry,

whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which waxes are tacky and would possess the property described in claim 1. Adequate written description requires more than a mere statement that it is part of the invention. See *Fieffs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the tacky wax having formula I shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first

paragraph. The specification does not teach any other waxes that are tacky actually possessing a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, and thus formula I disclosed in the specification is not representative of the genus because the genus is highly variant. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision (See page 1115).

Claim Rejections - 35 USC § 103

Claims 1-31 and 73-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of 5,985,298 ('298) and U.S. Patents 5,783,176 ('176).

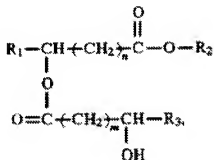
Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions (claim 99) and these compositions have wax. The compositions have volatile solvent and non-volatile oil, film former and emulsifier (surfactant claimed in claim 95). The waxes include Kester wax, which is also known as synthetic bees wax. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent, claim 74). Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 74-75). The weight percent of the solvent is also within the claimed range. Mascara composition has film former, which is polyethylene. Example 2 has 4 types of waxes. Example 2 has carnauba wax and candelillia wax. The weight percent disclosed in example 2 is within the weight percent claimed. Example 2 has additional wax which is claimed in claims 97-100. The weight percent disclosed in example 2 is within the weight percent claimed.. See also col.6, line 50 through col.7, line 32.Examples 1-5 do not have UV screening agent (claim 97). See all the examples drawn to various cosmetic formulations. The combination of volatile oil and non volatile solvent belongs to claimed fatty phase. See col.2, line 20 through col.4, line 21 for fatty phase. see col4,

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II 48-50, col.5, II 34-62. The weight percent of volatile solvent and non-volatile oil taught by the patent is within the weight percent claimed for the volatile oil and non-volatile oil (claims 79-86). See col. 4, II 22-24 for the various cosmetic products. Patent also teaches film formers at paragraph bridging cols 5-6 and teaches that various film formers disclosed in CTFA handbook can be used. The difference between the patent and the instant application is patent does not disclose formula I claimed in claim 21 for tacky wax.

However, patent '176 teaches tacky wax claimed in instant application as ester.

Patent '176 at col.4, II 1-20 teaches ester having the following formula in cosmetic formulations.

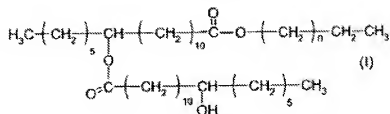


wherein

R1 and R3 independently of one another are a branched or unbranched saturated hydrocarbon radical having 3-30 carbon atoms and R2 is a branched or unbranched saturated hydrocarbon radical having 5-50 carbon atoms, and n and m independently of one another assume values from 5 to 25.

The tacky wax of claim 21 has the following formula:

11. The composition according to Claim 10, wherein the at least one C₂₀-C₄₀ alkyl (hydroxystearoyloxy)stearate is chosen from compounds of formula (I):



wherein n is an integer ranging from 18 to 38.

There is overlap regarding variables. In patent R1 can be 3-30 carbon atoms and in instant application R1 corresponds to 5 carbons. In patent n can be 5-25 and in instant application n is 10. In patent R2 can be 5-50 carbon atoms and in instant application the carbon range can be 20-41 (n=18-38). In patent m is 5-25 and in instant application the value is 10. In patent R3 can be 3-30 carbon atoms and in instant application the value is 6. Thus there is overlap with the ranges. See the abstract, see col.3, ll 30 through col.4, line 65 and see the paragraph bridging col.s 4-5. Patent at col.5, ll 35-45 teaches surfactants and at col.5, ll 52-61 teaches solvents and at col.8, ll 39-65 teaches conventional cosmetic additives. See the examples.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute synthetic bees wax for bees wax or synthetic wax taught in the mascara compositions. One of ordinary skill in the art would substitute the functional equivalents expecting that the synthetic bees wax can also be used in composition. With respect to claim 21, one of ordinary skill in the art would substitute the synthetic beeswax of patent '298 to ester of patent '176 (claimed in instant application as tacky wax and also known as synthetic wax since INCI name for Kester wax is synthetic bees

wax) . One of ordinary skill in the art would substitute the functional equivalents expecting that the ester of patent '176 (INCI name is synthetic bees wax) can also be used in composition. This is a prima facie case of obviousness.

Double Patenting

Claims 1-31 and 73-100 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 36-38, 40 , 42-44 and 50-62 of copending Application No. 10/656,201. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions. The structuring agent claimed in the co-pending application is drawn to tacky waxes and with respect to claim 21 of instant application the genus drawn to " tacky wax " of copending application anticipates the species drawn to claim 21 of instant application.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase

"consisting of" excludes any element, step, or ingredient not ~specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448,450 (Bd. App. 1948).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.